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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,866	03/22/2004	Robert Tod Dimpsey	AUS920040065US1	2686
35525	7590	06/25/2008		
IBM CORP (YA)			EXAMINER	
C/O YEE & ASSOCIATES PC			SAVLA, ARPAN P	
P.O. BOX 802333			ART UNIT	PAPER NUMBER
DALLAS, TX 75380			2185	
			NOTIFICATION DATE	DELIVERY MODE
			06/25/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptonotifs@yeeiplaw.com

Office Action Summary	Application No. 10/806,866	Applicant(s) DIMPSEY ET AL.
	Examiner Arpan P. Savla	Art Unit 2185

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 May 2008.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4-8 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-4-8 and 24 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 12, 2008 has been entered.

Response to Amendment

This Office action is in response to Applicant's communication filed May 12, 2008 in response to the Office action dated February 11, 2008. Claims 1 and 24 have been amended. Claims 12, 15-18, and 21-23 have been canceled. Claims 1, 4-8, and 24 are pending in this application.

REJECTIONS NOT BASED ON PRIOR ART

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 1, 4-8, and 24** are rejected under 35 U.S.C. 112, first paragraph as failing to comply with the description requirement thereof since the amendments to

claims 1 and 24 filed May 12, 2008 introduce new matter not supported by the original disclosure. The original disclosure does not reasonably convey to a designer of ordinary skill in the art that applicant was in possession of the design now claimed at the time the application was filed. See *In re Daniels*, 144 F.3d 1452, 46 USPQ2d 1788 (Fed. Cir. 1998); *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).

Specifically, there is no support in the original disclosure for “storing a first threshold value and a second threshold value in a first threshold field and a second threshold field”, the “plurality of counter fields”, “wherein the first threshold value specifies a maximum counter value in an associated counter field”, as well as “wherein the second threshold value specifies a minimum counter value in an associated counter field.” Nowhere in Applicant’s specification does it specifically disclose “a first threshold field”, a “second threshold field”, or even a “plurality of counter fields.” Applicant alleges that Figures 2, 9, 24, 25, and their associated text within the specification provide support for these features, however, the Examiner respectfully disagrees. The only “fields” mentioned in Applicant’s specification are “fields 910-950” of Fig. 9. As discussed on pages 34-35 of Applicant’s specification, field 910 is used for storing a virtual page address, field 920 is used for storing a physical page address, field 930 is used for indicating an instruction or memory access has occurred, field 940 is used for indicating the type of access that has occurred, and field 950 is used for storing prefetch information such as pointers, offsets, and addresses. Thus, based on Applicant’s specification, fields 910-950 have nothing to do with thresholds or counters. Additionally, since there is no disclosure in Applicant’s specification of the broadly

claimed "first threshold field", "second threshold field", or "plurality of counter fields" themselves, logically, it follows that there is also no disclosure in Applicant's specification that the "first threshold value specifies a maximum counter value in an associated counter field" or that the "second threshold value specifies a minimum counter value in an associated counter field." Accordingly, Applicant's amendments to claims 1 and 24 introduce new matter not supported by the original disclosure.

To overcome this rejection, Applicant may attempt to demonstrate that the original disclosure establishes that he or she was in possession of the amended claim.

Conclusion

STATUS OF CLAIMS IN THE APPLICATION

The following is a summary of the treatment and status of all claims in the application as recommended by MPEP 707.70(i):

Allowable Subject Matter

3. **Claims 1, 4-8, and 24** would be allowable if rewritten or amended to overcome the 35 U.S.C. 112, first paragraph rejections, set forth in this Office action.

Claims Rejected in the Application

4. Per the instant office action, **claims 1, 4-8, and 24** have received a first action on the merits and are subject of a first action non-final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arpan P. Savla whose telephone number is (571)272-1077. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sanjiv Shah can be reached on (571) 272-4098. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Arpan Savla/
Examiner, Art Unit 2185
June 16, 2008

/Sanjiv Shah/
Supervisory Patent Examiner, Art Unit 2185